

Application No. 10/096,675
Amendment dated October 26, 2004
Reply to Office action of August 10, 2004

REMARKS:

Status Of Claims

Claims 1-28 were previously pending, claims 8 and 12 have been amended, and new claims 29 and 30 have been added. Thus, claims 1-30 are currently pending in the application with claims 1, 12, 15, 24, 29, and 30 being independent.

Office Action

In the office action, the Examiner objected to the disclosure for failing to indicate that the present application is a continuation. This has been corrected.

The Examiner rejected claims 1-8, 10-12, 17, 20, and 21 under 35 U.S.C. 103(a) as being unpatentable over White et al., U.S. Patent No. 6,532,152, in view of Maeda et al., U.S. Patent No. 6,356,259. The Examiner also rejected claims 13 and 14 under 35 U.S.C. 103(a) as being unpatentable over White and Maeda in further view of Shimada et al., U.S. Publication No. 20020152025. The Examiner also rejected claims 15, 16, 18, 19, and 22-28 under 35 U.S.C. 102(e) as being anticipated by White. Applicant respectfully submits that the currently pending claims distinguish the present invention from White, Maeda, Shimada, and the other prior art references of record, taken alone or in combination with each other.

Specifically, claim 1 recites a "mounting member including" "a first leg positioned away from a top of the housing and attached to a first shock absorbing member" and "a second leg positioned away from the top of the housing and attached to the first shock

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absorbing member and an adhesive". This structure is best shown in FIG. 7 and described on pages 16-18, of the present specification:

As shown in FIG. 7, the touch panel 720 is shock-mounted using a first viscoelastic shock mount member 760 and a second viscoelastic shock member 762. The first viscoelastic shock member 760 is sandwiched between an edge of the touch panel 720 and a portion of the first leg 744 and a portion of the second leg 745. As shown in FIG. 7, the bottom portion of the second leg 745 of the mounting apparatus is entirely covered to sandwich the first viscoelastic member 760 between the two legs 744, 745 of the mounting apparatus and the edge of the display 720.

As shown in FIG. 7, the legs 744,745 of claim 1 form two pockets 741,742. "Within the pocket 741 is a flexible adhesive 770", as stated on page 17, line 4. Finally, as shown in FIG. 7, the flexible adhesive contacts the second leg 745.

In contrast, neither White nor Maeda disclose such structure. For example, as argued in a preliminary amendment, "the White reference appears to describe a U-shaped shock absorbing frame made of foam (See col. 14, lines 14-15; reference numeral 300)". White's frame is the closest component that might be considered analogous to the shock absorbing member of claim 1. However, White simply does not disclose any structure analogous to the legs of claim 1, much less "a second leg ... attached to the first shock absorbing member **and an adhesive**", emphasis added, as claimed in claim 1. Rather than any leg being attached to an adhesive, White's shock absorbing frame may be attached to an adhesive. As a result, no combination of White and/or Maeda discloses,

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suggests, or makes obvious "mounting member including" "a first leg positioned away from a top of the housing and attached to a first shock absorbing member" and "a second leg positioned away from the top of the housing and attached to the first shock absorbing member and an adhesive", as claimed in claim 1.

Obviousness, it will be appreciated, can be a problematic basis for rejection because the Examiner, in deciding that a feature is obvious, has benefit of the Applicant's disclosure as a blueprint and guide, whereas one with ordinary skill in the art would have no such guide, in which light even an exceedingly complex solution may seem easy or obvious. Furthermore, once an obviousness rejection has been made, the Applicant is in the exceedingly difficult position of having to prove a negative proposition (i.e., non-obviousness) in order to overcome the rejection. For these reasons, MPEP § 2142 places upon the Examiner the initial burden of establishing a *prima facie* case of obviousness. If the Examiner fails to establish the requisite *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Only if the Examiner's burden is met does the burden shift to the applicant to provide evidence to refute the rejection.

Specifically, the Examiner must satisfy three criteria in order to establish the requisite *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or

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combination of references) must teach or suggest all the claim limitations. MPEP §706.02(j), citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

In meeting this initial burden, as stated in MPEP §2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

In the present case, as discussed above, neither White nor Maeda discloses any structure analogous to the legs of claim 1, much less "a second leg ... attached to the first shock absorbing member **and an adhesive**", emphasis added, as claimed in claim 1. As the Examiner has failed to identify prior art that teaches each of the claimed limitations, the Examiner has failed to establish the requisite *prima facie* case of obviousness with regard to the current obviousness rejections. Therefore, the current obviousness rejections cannot be sustained.

Claim 5 depends from claim 1 and recites "wherein the adhesive is rigid". The Examiner mistakenly asserts that Maeda discloses use of a rigid adhesive. In fact, as disclosed in column 7, lines 41-53:

The reactive adhesive used in the above described embodiment exhibits elasticity upon hardening. The characteristic of elasticity permits upper transparent plate 2 to move elastically in a horizontal direction that is parallel to the X, Y plane. The capability of elastic movement is in a horizontal direction relative to adhesive layer 10 and lower transparent substrate 3. This

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configuration permits a reliable contact between conductor layers 4, 5 even when pressure is applied to input surface 2a in a region near adhesive layer 10. In such an instance, upper transparent plate 2 flexes elastically inward toward lower transparent substrate 3 to provide a consistent, resilient mechanism for creating contact between conductor layers 4, 5.

Thus, Maeda's adhesive is disclosed to be, and indeed must be, flexible in order to allow his transparent plate to flex inwardly. As a result, no combination of White and/or Maeda discloses, suggests, or makes obvious "wherein the adhesive is rigid", as claimed in claim 5.

Claim 8 also depends from claim 1 and now recites "a backing member that fits within the housing, the backing member having a portion positioned near the touch panel" and "a second shock absorbing member opposite the first shock absorbing member and including a portion which is sandwiched between the backing member and the layer of rigid material of the touch panel". As shown in FIG. 7 and described on page 17 of the present specification, a "second viscoelastic member 762 is sandwiched between the backing member 750 and the edge of the touch panel 720". Thus, claim 8 requires a touch panel to be supported by two legs attached to a first shock absorbing member and a second shock absorbing member sandwiched between a backing member and the touch panel. Furthermore, according to claim 8, the two shock absorbing members must be located on opposite sides of the touch panel.

In contrast, neither White nor Maeda discloses such structure. For example, White discloses only one shock absorbing member positioned only on one side of the

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touch panel. As a result, no combination of White and/or Maeda discloses, suggests, or makes obvious "a backing member that fits within the housing, the backing member having a portion positioned near the touch panel" and "a second shock absorbing member opposite the first shock absorbing member and including a portion which is sandwiched between the backing member and the layer of rigid material of the touch panel", as claimed in claim 8.

Claim 12 now recites "a fluid seal securing the touch panel to the housing, the fluid seal being disposed in front of the periphery of and around an outer edge of the touch panel and compressed toward the mounting member by a backing bracket to provide a water proof seal and a shock mount". Support for this amendment may be found, among other places, in FIGs. 7-9. Specifically, FIGs. 7-9 show the adhesive 770,870,971, respectively, both "in front of the periphery of and around an outer edge of the touch panel", as now claimed in claim 12. An advantage of this construction is that the seal may bond to both the flexible layer and the layer of rigid material of the touch panel, thereby forming a superior seal.

In contrast, neither White nor Maeda disclose the claimed structure. For example, while White shows a gasket in front of the periphery of the touch panel, White's gasket does not extend rearwardly and around an outer edge of the touch panel. Therefore, White's gasket can only bond with the flexible layer of his touch panel, thereby creating an inferior seal. As a result, no combination of White and/or Maeda discloses, suggests, or makes obvious "a fluid seal securing the touch panel to the housing, the fluid seal being disposed in front of the periphery of and around an outer edge of the touch panel and

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compressed toward the mounting member by a backing bracket to provide a water proof seal and a shock mount", as claimed in claim 12.

Claim 15 recites "dead reckoning component in communication with the processor and operable to detect a position of the hand-held electronic device when GPS signals are unavailable". For example, as stated, among other places, on page 13, lines 1-2, an "rate gyro 390 is used for calculating routings when a navigational signal is lost". Thus, as previously argued, the dead reckoning component of claim 15 is used to determine position independently of, or as a replacement for, the GPS signals.

In contrast, neither White nor Maeda disclose the use of any dead reckoning component. For example, White only discloses use of a GPS receiver, and therefore does not disclose use of any navigational component "when GPS signals are unavailable, as claimed in claim 15.

While Shimada does disclose the use of a gyro, Shimada's gyro is only used in combination with a GPS receiver. For example, as disclosed in ¶ 58:

Numeral 11 denotes a bearing sensor of a gyro, a geomagnetic sensor, etc., for detecting the bearing of the mobile unit, numeral 12 denotes a speed sensor for detecting the speed and the move distance of the mobile unit, and numeral 13 denotes a GPS receiver for calculating the current position based on information received from a GPS satellite, the components 11, 12, and 13 corresponding to the position detection means ...

Thus, Shimada detects position using both the gyro and the GPS receiver. As disclosed in ¶ 2 and ¶ 8, this is done to calculate a differential between a route actually

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traveled and a planned route. Thus, Shimada uses the gyro and speed sensor, as a supplement to, rather than a replacement for, the GPS signals.

Instead, Shimada actually uses map data to 'fill-in' a route, when GPS signals are lost. For example, as disclosed in ¶ 64 and ¶ 65, when a route becomes discontinuous, due to a detection error, such as signal loss, the discontinuity is corrected "by complementing the discontinuous part based on the peripheral map information". In other words, map information is used to 'fill-in' any blanks caused by the detection error. Therefore, Shimada discloses use of map data "when GPS signals are unavailable", rather than a dead reckoning component, as claimed in claim 15. As a result, no combination of White, Maeda and/or Shimada discloses, suggests, or makes obvious "dead reckoning component in communication with the processor and operable to detect a position of the hand-held electronic device when GPS signals are unavailable", as claimed in claim 15.

Claim 16 depends from claim 15 and recites "wherein the antenna is an internal patch antenna". The antenna of claim 16 is shown, among other places, in FIGs. 2A, 2D, 3, and 5 and identified by reference numeral 216, 316, and 516, respectively. Thus, as can be seen in the figures, claim 16 requires that the antenna be internal to the housing.

In contrast, none of the references made of record shows this structure. In fact, White shows just the opposite and is replete with references to antenna connectors penetrating his housing for use with an external antenna. For example, White's FIGs. 2, 4, 5, 7, 8, 9, 11, and 12, along with column 12, line 53, through column 13, line 9, disclose "[a]ntenna connectors 224 and 226 [which] allow antennas 225 and 227 to be removably attached". More specifically, White actually requires removable attachment of these

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external antennas. For example, beginning in column 12, line 64, through column 13, line 9, White discloses:

A plurality of antenna connections is preferably provided because the computer 200 according to the present invention will most advantageously comprise more than one wireless data link. Because the wireless data links employed may be selected from any number of wireless data link types, and because it may be desirable to replace the radio transceivers, for example, as a part of an equipment upgrade or modification, the use of removable antennas in accordance with the present invention proves advantageous in allowing a user to provide properly matched antennas for the types of wireless receiver or transceiver cards or modules employed.

Thus, White actually teaches away from use of "an internal patch antenna", as claimed in claim 16. Additionally, since "the wireless data links employed may be selected from any number of wireless data link types", as discussed above, White must retain the flexibility of external antennas. Therefore, White cannot be modified to use of "an internal patch antenna", as claimed in claim 16, as such modification would render White unsatisfactory for its intended purpose. Thus, there can be no suggestion or motivation to modify White to use "an internal patch antenna", as claimed in claim 16. MPEP §2143.01. As a result, White simply does not disclose, suggest, or make obvious "wherein the antenna is an internal patch antenna", as claimed in claim 16.

Claim 24 recites "an antenna within the housing for communicating with the server". In contrast, as discussed above, White actually teaches away from, and cannot be

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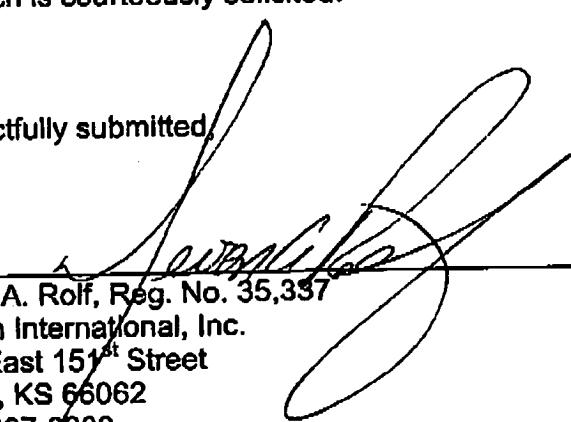
modified to include "an antenna within the housing", as claimed in claim 24. More specifically, because White's "wireless data links ... may be selected from any number of wireless data link types", "[a]ntenna connectors 224 and 226 [must be used to] allow antennas 225 and 227 to be removably attached". As a result, White simply does not disclose, suggest, or make obvious "an antenna within the housing for communicating with the server", as claimed in claim 24.

The Examiner indicated that claim 9 would be allowable, if rewritten in independent form. Thus, claim 29 is claim 9 rewritten in independent form. Claim 30 has been added to further distinguish the present invention from the prior art. The remaining claims all depend directly or indirectly from independent claims 1, 11, 16, or 24 and are therefore also allowable.

Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 501-791. In view of the foregoing, a Notice of Allowance appears to be in order and such is courteously solicited.

Respectfully submitted,

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